

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested in view of the results of a telephone interview with the Examiner, the present amendment, and the following discussion.

This Amendment is in response to the Final Office Action mailed on July 16, 2003. Claims 1-5, 7, and 8 are pending in this application and stand rejected. Applicants have amended Claims 1 and 8, cancelled Claim 3 without prejudice or disclaimer, and submitted new Claims 9 and 10.

Claims 1-8 stand rejected under 325 U.S.C. § 102(b) as being anticipated by Shibata (U.S. Patent No. 6,409,574, hereinafter "Shibata").

Applicants acknowledge with appreciation the courtesy of a telephone interview with Examiner Yaritza Guadalupe on October 16, 2003. During the interview, amendments to Claim 1 as herein submitted were discussed and arguments as hereinafter developed were presented. An agreement was reached that the finality of the outstanding Office Action was going to be withdrawn and that the presently amended Claim 1 would receive favorable reconsideration.

According to a feature of the invention as set forth in the presently amended Claim 1, a lens shape measuring apparatus is disclosed comprising, among other limitations, an arithmetic control means for measuring the shape of the lens and for identifying a shape of a lens fixing jig. In addition, previously submitted Claim 7 recites the limitation that the arithmetic control means also measures a size of an outer shape of the lens fixing jig.

As disclosed in the Specification, besides the structural features to enable a user to measure the shape of a lens and grinding the lens to the measured shape, the ability to identify and/or measure the shape of the lens fixing jig in such an apparatus is advantageous, among other reasons, for preventing accidents related to grinding the lens fixing jig together

with the lens to be ground (Specifications, page 2, lines 13-15, and FIG. 23 of Applicants' Specification), and for preventing an incorrect measurement of the outer diameter of a small lens (such as a crab-eye lens) and an application of excessive force to the measuring element, thereby preventing the element from being broken (Specifications, page 2, line 22 – page 3, line 1). Presently amended Claim 1 more clearly recites such an apparatus.

As discussed in the telephone interview, Applicants respectfully submit that Shibata does not teach or disclose an apparatus having arithmetic means for identifying and/or measuring a shape of the lens fixing jig. The only apparatus disclosed by Shibata is one to measure the shape of a lens and to grind the lens according to the desired measured shape (see, for example, Shibata, col. 17, line 45; col. 18, lines 6-8; col. 18, lines 37-40; col. 18, lines 50-61; and col. 18, lines 62-65). In fact, Shibata is silent with respect to any feature of his apparatus to measure or identify the shape of a lens fixing jig.

In response to Applicants' arguments filed on May 2, 2003, which arguments are herein incorporated by reference in their entirety, the outstanding Office Action inherently acknowledges that the apparatus of Shibata does not have arithmetic means for identifying a shape of the lens fixing jig by stating that "the control unit disclosed by Shibata is capable to perform the process of measuring a size of an outer shape of the lens fixing jig based on a signal from the measuring unit if programmed to do so, since it only involves the use of an adequate software or programming by the user" (Final Office Action, page 5, lines 13-16). It was further asserted that "apparatus claims must be structurally distinguishable from the prior art . . . in terms of structure rather than function." However, Applicants respectfully submit that such a position does not recognize the fact that (1) there are many structural differences between the apparatus of Shibata and Applicants' claimed invention; and (2) the limitation lacking in Shibata is recited in the presently amended Claim 1 and previously presented Claim 7 in means-plus-function language.

As to structural differences, consider, for example only and not intended as an exhaustive list, the fact that in Shibata (1) the measurement of the position of several of the moving parts are effected by encoded motors, e.g., stepper motors, wherein in the instant invention, although other devices can also be used including stepper motors, an electromagnetic induction system is used in conjunction with the moving amount detecting sensor 129 (Specifications, page 31, lines 22 – page 32, line 8); (2) the force applied to the grinding lens is detected by the current provided to the encoded motor, thus limiting the torque applied, wherein in the instant invention such a force, although also capable of being measured and controlled by the electric power supplied to a stepper motor, the pressure adjusting mechanism 45 is used as illustrated in Applicants' FIG. 7 and discussed on page 22, line 20 to page 24, line 13 of Applicant's Specification; and (3) no use is disclosed of light sources and light blockers to control position or movement of several subparts in his apparatus, wherein Applicants' disclosure include at least two examples of such devices (see, for example, the light source 143 and the light shielding plate 142 used in the rotating measure apparatus 108 as well as the use of small-width light shielding plate 116b1 in the measuring unit 42).

Although, as just summarized, several structural differences do exist, Applicants respectfully submit that, given the fact that Claim 1 is written in means-plus-function language, under the provisions of 35 U.S.C. § 112, sixth paragraph, there is no need for the recitation of structural features, and such claim should be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Therefore, based at least on the foregoing reasons, Applicants respectfully submit that independent Claims 1 and 7 are not anticipated by Shibata because each and every element as set forth therein is not found, either expressly or inherently described, in the cited reference.

In an anticipation rejection, MPEP § 2131 requires that the identical invention must be shown in as complete detail as is contained in the claim. Shibata does not teach or disclose an apparatus for measuring the shape of a lens having an arithmetic control means for measuring the shape of the lens and for identifying (Claims 1 and 7) and measuring (Claim 7) a shape of a lens fixing jig. In addition, Claims 2, 4, 5, and 8 are allowable, among other reasons, as depending either directly or indirectly from Claim 1, which is allowable. Therefore, Applicants respectfully request that the anticipation of Claims 1-8 under 35 U.S.C. §102(b) be withdrawn and the claims passed to issuance.

Applicants have also submitted herein new Claims 9 and 10, reciting additional features and limitations of the arithmetic means for measuring the size and/or shape of a lens fixing jig. In new Claim 9, the arithmetic control means of Claim 1 is further limited to move the feeler of the measuring element relatively in the direction roughly parallel to the lens rotation shaft, measure a distance from a measuring reference position of the measuring element to an abutting position of the same by the measuring unit, and identify the shape of the lens fixing jig based on a result of the measurement. These limitations of Claim 9 were originally recited in Claim 6, now cancelled.

In new Claim 10, among other recited limitations, a lens shape measuring apparatus, is recited comprising a lens fixing jig; a lens rotation shaft; a measuring element having a feeler abutted on a refracting surface of the lens clamped by the lens rotation shaft; a measuring unit for measuring a moving distance of the feeler of the measuring element; and arithmetic control means for identifying a shape of the lens fixing jig, wherein the arithmetic control means controls the feeler of the measuring element to move on the lens fixing jig such that the feeler is positioned above the lens fixing jig, controls the moving distance of the feeler of the measuring element such that the feeler is close to said lens fixing jig, and detects whether or not the feeler is abutted on a side face of the lens fixing jig and judges whether or

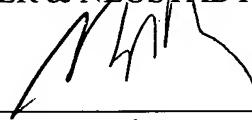
not the lens fixing jig is large or small in diameter to identify the shape of the lens fixing jig. Support for the subject matter recited in Claim 10 is found, among other locations, in the as-filed FIGS. 5 and 11-15 and the associated disclosure text as well as on pages 38-43 of Applicants' Specification, disclosing the lens fixing jig size detection system. Based at least on the foregoing reasons, Applicants respectfully submit that Claims 9 and 10 are not anticipated or obviated by Shibata.

Furthermore, Applicants respectfully submit that Claims 1 and 7 and the newly submitted independent Claim 10 are also not rendered obvious by Shibata. As already explained, Shibata is silent with respect to means for identifying the shape and/or measuring the outer size of the shape of a fixing jig in a lens shape measuring apparatus. In addition, Shibata is silent with respect to any of the problems associated with the lack of the ability of his apparatus to make such measurements and identifications. Therefore, Applicants respectfully submit that based on the teachings of Shibata, one of ordinary skill in the art would not be lead to add to the apparatus of Shibata means for identifying the shape and/or measuring an outer size of the shape of a fixing jig in a lens shape measuring apparatus. A conclusion to the contrary could only be reasonably explained based on a reconstruction of Applicants' apparatus based on the use of unauthorized hindsight.

Based at least on the foregoing reasons, Applicants believe the present application is in condition for allowance and respectfully solicit an early Notice of Allowability of Claims 1, 2, 4, 5, and 7-10.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



---

Gregory J. Maier  
Registration No. 25,599  
Robert T. Pous  
Registration No. 29,099  
Attorneys of Record

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 08/03)

GJM:RTP:MQM:psn

I:\ATTY\MQM\21's\218278USAM.doc